

Serial No.:
Page 2

which, as stated by the Examiner, holds that:

"A person shall be entitled to a patent unless --
(a) the invention was known or used **by others** in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent...." (boldface added)

Applicants' **own** description in a printed publication is **not** a description by **others**.

If the Examiner has a Section 102 rejection, it is presumably under 35 U.S.C. §102(b) which states:

"A person shall be entitled to a patent unless --

...
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application in the United States...."

The date of Applicants' application in the United States is June 14, 2000. The Examiner cites Applicants' **own** paper only as originating from "IEEE Radio Frequency Integrated Circuits Symposium, 1999".

The paper is in fact from the **1999 IEEE Radio Frequency Integrated Circuits (Rfic) Symposium: Digest of Papers** published by the IEEE is ISBN 0780356047 in **September, 1999**. Witness the attached EXHIBIT A. Ergo there was no descr[aption] in a printed publication in this... country... more than one year prior to the [June 14, 2000] date of the application".

Even the subject symposium itself was held from Sunday, June 13, 1999 -- a check-in day -- through Tuesday, June 15, 1999. Witness the attached EXHIBIT B. Even if Applicants, or either of them, were to have distributed pre-prints of their paper in accompaniment to their talk -- which talk could not be and was not earlier than June 14, 1999 -- then this description in a printed publication would **not** be **more** than one year prior to the June 14, 2000, filing date of Applicants' application. (Indeed, the notation "TUES5-4"

appearing at the top of the cited reference paper **probably** means that the paper was (orally) presented in section 5-4 of the conference on Tuesday, June 15, 1999.)

Likewise, the rejection under 35 U.S.C. 103 is unsound, the primary reference simply **not** being "prior art" to Applicants' application, and invention.

No Affidavit under 37 C.F.R. 131 in order to overcome a "rejection under 35 U.S.C. 102(a) or (e) or 35 U.S.C. 103 based on a U.S. patent to another or others..." (37 C.F.R. 131) is pertinent under these facts. See MPEP §715.

Applicants supply in their accompanying EXHIBITS a prima facie case that the primary reference cited by the Examiner is **not** prior art to Applicants' invention. They are not **now** required to swear to that effect.

If the Examiner hews to his position that the primary reference **is** prior art -- which position he should, with all due respect, support by some assertion of fact(s) such as that he finds (i) the reference published paper to precede the operative date of June 14, 1999, and/or (ii) the published paper is by persons other than Applicants -- **then** the Examiner should revise the statutory basis of his rejection, probably to be under 35 U.S.C. §102(b). (Being that this would be a new basis for rejection, the Office Action would properly **not** be a final Office Action.) At that time, and upon that hypothetical rejection, Applicants appropriate response **might then** include an Affidavit Under 37 C.F.R. §132.

2. Summary

The present amendment and remarks have overcome and discussed each of the bases for the rejections presented in the Office Action. No new subject matter has been introduced by the present amendment.

In consideration of the preceding amendment and

Serial No.:
Page 4

accompanying remarks, the present application is deemed in condition for allowance. The timely action of the Examiner to that end is earnestly solicited.

Applicant's undersigned attorney is at the Examiner's disposal should the Examiner wish to discuss any matter which might expedite prosecution of this case.

Sincerely yours,

William C. Fuess

William C. Fuess
Registration Number 30,054

FUESS & DAVIDENAS
Attorneys-at-Law
10951 Sorrento Valley Road
Suite II-G
San Diego, California 92121-1613
Telephone: (858) 452-8293
Facsimile: (858) 452-6035
E-mail: fuess@pacbell.net

William C. Fuess
[X] Attorney of Record
[] Filed Under 37 CFR §1.34(a)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on the date written below.

April 17, 2003 William C. Fuess
Date Typed Name of Person
Mailing Correspondence

William C. Fuess
Signature of Person Mailing
Correspondence